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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,259	05/11/2001	Andrew Tibbs	18360/206856	5032
826	7590	04/06/2006	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			BASS, JON M	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/853,259	Applicant(s) TIBBS ET AL.	
	Examiner Jon Bass	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/26/2006 ; 1/27/2006 (4 pages)</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status Of Claims

1. Claims 1-20 are pending in this application. Claims 1, 2, 12 and 20 have been amended.
2. Due to the recent Board of Patent Appeals and Interfaces decision in Ex Parte Carl A. Lundgren (Appeal No. 2003-2088), the 35 U.S.C. § 101 rejection has been withdrawn.

Response to Amendment

3. Applicant arguments filed on December 13, 2205 have been fully and completely considered but are not found to be persuasive.
4. Applicant argues, (with regard to Claim 1), that Daniel Williams et al. (U.S. Pub No. 2002/0032612 A1) does not teach or suggest "transmitting and shipping information to a carrier server, said carrier server capable of processing said shipping information and generating said electronic return shipping label based at least in part on said shipping information". Examiner notes that Williams does

disclose that a Return Merchant Service System is used to interface (used as a transmitting source) and interacts with a system to provide various shipment management functions through Application Program Interfaces (API) and web-based interfaces, including but not limited to shipment rating, shipment labeling, shipment tracking. Williams continue to disclose that each merchant's customers is provided with pricing of shipping rates for various shipping options, processing of returns requests, printing of shipping, labels, disclosed on page 3, 0030. Williams further discloses on page 34, 0529, that the Merchant system uses the information contained in the API which contains labeling instructions with which the Customer can print appropriate type of label with which to facilitate the shipping of the item to be returned using the Customer-selected carrier and service.

5. The applicant argues that the iReturn System is not a carrier, which generates the shipping label. The Examiner respectfully disagrees with this characterizations posed by the applicant. The Examiner notes that in invention disclosed by Williams are separated into "Traveler Label" and "iReturn System". Williams discloses on page 36, 0564,

that Valid Carrier Identifiers are linked to Label Types. This suggests that carriers has access to this system and is fully capable of printing the label. To distinguish the difference between the two types of system, described is "Traveler Labels". Williams discloses on page 42, 0783, "Travel Labels", which is used as an option by the customer when preparing packages for shipping and printing what a retailer refers to herein as a "Traveler Label". The main difference is that carrier has access to allow for the label to be generated. With these two being distinguished a clearer understanding of the iReturn System is revealed. Therefore, Williams discloses that the carriers linked to Label Types prints the shipping label. In addition, due to the reasons set forth in the Office Action and the reasons set above, 35 U.S.C. § 102 rejection remain.

6. Claims 2-11 depend from Independent Claim 1 and include all of the limitations of that Claim, Thus for at least the reasons set above with respect to the amended claims, the 35 U.S.C. § 102 rejection remain.
7. Applicant argues (in regard to Claim 12), that Williams does not teach or suggest "transmitting said shipping

information to a carrier server, said carrier server configured to process said shipping information and generate said return shipping label; or generating said return shipping label at said carrier server, wherein said carrier server is further configured to provide said customer electronic access to said return shipping label". The Examiner respectfully disagrees with the characterization of the inventive concept. The Examiner notes that on page 34, 0529, that iReturn Merchant Service System uses the information contained in the Return API request to prepare the labeling instructions for a return. In addition, printing the label to facilitate the shipping of the item to be returned using the Customer selected carrier and service. This suggests that transmission of the shipping information has occurred. The carrier has access to the iReturn System. The carrier decides on the shipping rate and the carrier to be assigned. Therefore, for at least the reasons set above the 35 U.S.C. § 102 rejection remain.

8. Claims 13-19 depend from Claim 12 and includes all the limitations of that Claim. For at least the reasons set within the Previous Office Action mailed September 20, 2005

and for at least the reasons set above the rejections remain.

9. The applicant argues (in regard to Claim 20), that Williams does not disclose or teach " an application service provider application, residing on said carrier configured to generate said return shipping label based in part on shipping information received from said merchant server".. The Examiner notes that on page 34, 0529, that iReturn Merchant Service System uses the information contained in the Return API request to prepare the labeling instructions for a return. In addition, printing the label to facilitate the shipping of the item to be returned using the Customer selected carrier and service. This suggests that transmission of the shipping information has occurred. The carrier has access to the iReturn System. The carrier decides on the shipping rate and the carrier to be assigned. Therefore, for at least the reasons set above the 35 U.S.C. § 102 rejection remain.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Daniel Williams et al (US Pub No. 2002/0032612 A1), hereinafter referenced as Williams.

As Per Claim 1:

Williams discloses a method for a merchant, [{fig 1, 2a}, merchant] to provide an electronic return shipping label to a customer to allow said customer to return goods, comprising the steps of, [{fig 6}, log on screen in an embodiment of the return system]:

receiving a return request for said goods from said customer, [{{fig 7}}, Return System Page];

obtaining shipping information related to said return request, [{{fig 7}}, Return System Page]; and

transmitting and shipping information to a carrier server, said carrier server configured to process said shipping information and generating said electronic return shipping label based at least in part on said shipping information; [{{page 3, 0030}}, and {page 34, 0529}]

receiving said electronic return shipping label from said carrier server; and [{{page 3, 0030}}, and {page 34, 0529}]

electronically providing said customer with said return shipping label that can be printed and affixed to a package for returning said goods, [{{fig 6}}, log on screen in an embodiment of the return system].

As Per Claim 2:

Williams discloses a method wherein receiving a return request for said goods from said customer comprises receiving said return request through a merchant website, [{{fig 5e, 21m-21r}}, web server] associated with a merchant server, [{{fig 2, 20a}}, system server].

As Per Claims 3, 13 and 14:

Williams discloses a method wherein receiving a return request for said goods from said customer comprises said customer contacting a representative of said merchant and said representative submitting said return request through a merchant website associated with a merchant server, [{fig 6}, Log on Screen in an embodiment of the Return System].

As Per Claim 4:

Williams discloses a method wherein said shipping information, [{fig 3b, 1215}, shipping station] related to said return request comprises a customer address and information, [{fig 6, 120} and {fig 8, 145} and {fig 10}; customers information and users name and return centers information] related to the size and weight, [{fig 2, 1024}, scale] of said goods that are being returned].

As Per Claims 5 and 15:

Williams discloses a method wherein at least a portion of said shipping information related, [{fig 12}, return shipping Options Screen] to said return request is obtained from a customer order database, [{fig 3a, 22, 28-30}, database].

As Per Claims 6 and 16:

Williams discloses a method wherein at least a portion of said shipping information related, [{{fig 12}}, return shipping Options Screen] to said return request is obtained from a product database [{{fig 3a, 22, 28-30}}, database].

As Per Claims 7and 17:

Williams discloses a method wherein said electronic return shipping label is formatted as an HTML document, [{{fig 13j-1}} web page link and {fig 27b}}, HTML image size].

As Per Claims 8 and 18:

Williams discloses a method wherein electronically providing said customer with said return shipping label that can be printed and affixed to a package for returning said goods, [{{fig 7}}, Return System home page] comprises providing said customer with a URL address that corresponds to said return shipping label, [{{fig 27a, 450}}, tracking number].

As Per Claims 9 and 19:

Williams discloses a method wherein electronically providing said customer with said return shipping label that can be printed and affixed to a package for returning said goods,

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[{fig 7}, Return System home page] comprises providing said customer with a file containing an electronic image of said . return shipping label, [{0278} determine the Image Size].

As Per Claim 10:

Williams discloses a method further comprising the step of said merchant authorizing said return request, [{fig 25}, Merchant Main Menu Choices].

As Per Claim 11:

Williams discloses a method wherein electronically providing said customer with said return shipping label comprises sending said return shipping label to a carrier with instructions to pick up said goods from said customer, [{fig. 3a}, carriers service].

As Per Claim 12:

Williams discloses a method for a merchant, [{fig 1, 2a}. merchant] to provide an electronic return shipping label to a customer to allow said customer to return goods, comprising the steps of, [{fig 6}, log on screen in an embodiment of the return system]:

receiving a return request for said goods from said customer, Return System Page];

obtaining shipping information related to said return request, [{fig 7}, Return System Page];

transmitting said shipping information to carrier server, said carrier server configured to process said shipping information and generate said return shipping label, [{fig 7}, return system home page] and {page 34, 0529}};

generating said return shipping label at said carrier server, wherein said carrier server is further configured to provide said customer electronic access to said return shipping label; [{page 34, 0529}}]

As Per Claim 20:

Williams discloses a system for a merchant to electronically provide a return shipping label to a customer that wishes to return goods, comprising, [{fig 6}, log on screen in an embodiment of the return system]:

a merchant server, hosting a merchant website and capable of communicating with a carrier server and at least one customer computer, [{fig 3a, 8n}, buyers computer];

a carrier server in communication with said merchant server, [{fig 3a, 8a, 8n}, sellers computer, buyer computer];

an application service provider application, residing on said carrier server configured to generate said return shipping label based at least in part on shipping information received from said merchant server, [fig 27b, 1254], generate label] and [page 34, 0529]; and

a customer computer for receiving said return shipping label, [fig 3a, 8n], buyers computer] and [page 34, 0529]].

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any concerns in regard to this communication, the examiner **Jon Bass** can be reached at (571) 272-6905 between the hours of 9-6pm Monday through Friday. The fax number for the establishment where the application is being process is (571) 273-8300.

If an attempt to reach the examiner is unsuccessful for any reason, the examiner's immediate supervisor, **John Hayes** can be reached at (571) 272-6708.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-271-9197 (toll free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/O Technology Center 3600

Washington, D.C. 20231


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER